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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN T. KANEFSKY, MICHAEL KOCHEISEN,
DAVID P. KORMANN, and BERNARD S. RENGER

Appeal 2008-004751
Application 09/801,635
Technology Center 2400

Decided: July 27, 2009[1]

Before JAMES D. THOMAS, THU A. DANG, and STEPHEN C. SIU, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Statement of the Case

This is an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-42. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Invention

Embodiments of the invention allow the convenient transmission of URLs or content corresponding to URLs from a WAP/i-mode-enabled mobile device to any other device across a network. In an embodiment, a URL corresponding to content accessed by WAP/i-mode-enabled mobile device is transmitted to an application server. The WAP/i-mode-enabled mobile device further transmits a destination address for the content to the application server. The application server then transmits the URL corresponding to the content to the destination address. The URL can then be used to render the corresponding content at the destination address. (Abstract, Spec. 29, and Fig. 2).

Representative Claim

19. A method for transmitting content from a WAP/I-mode-enabled device, the method comprising:

> receiving a command from a WAP/i-mode-enabled device for transmission of a first URL that is accessed by the device;
>
> receiving a destination address for transmission of the first URL;
>
> generating a message including an indication of a second URL, a file associated with the second URL including a

modified version of the content corresponding to the first URL; and

transmitting the message to the destination address.

Prior Art and Examiner's Rejections

Nykanen	US 6,661,784 B1	Dec. 9, 2003 (filed Mar. 2, 1999)
Darago	US 6,170,014 B1	Jan. 2, 2001 (filed Mar. 18, 1999)
Osaku	US 6,061,738	May 9, 2000

Claim 19 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Nykanen. All remaining claims on appeal stand rejected under 35 U.S.C. § 103. As evidence of obviousness as to claims 1-8, 15-18, and 20-42 in a first stated rejection, the examiner relies upon Nykanen and in view of Darago. To this combination of references, in a second stated rejection, the Examiner adds Osaku as to claims 9-14.

Analysis

Rejection under 35 U.S.C. § 102

As reproduced earlier in this opinion, independent claim 19 in part recites the generation of the message including an indication of a second URL. That clause continues with the recitation "a file associated with the second URL including a modified version of the content corresponding to the first URL." The Examiner's correlation of this claim at page 5 of the Answer in the statement of the rejection, as well as the slightly rewritten and expanded position of the Examiner in the responsive arguments portion at page 17 of the Answer, do not address this limitation. Instead, the Examiner

appears to be of the mistaken belief that independent claim 19 includes the recitation that the first URL and the second URL are identical.

The basic theme of the Appellant's remarks at page 14 of the Brief as to this rejection is that Nykanen fails to teach each and every element of claim 19. In fact, the quoted feature we recited in the previous paragraph is specifically argued at page 15 of the Brief as not being met by the teachings of the reference as outlined by the Examiner. We agree.

Therefore, we must reverse the rejection of independent claim 19 as being anticipated by Nykanen.

Rejections under 35 U.S.C. § 103

The first stated rejection under this statutory basis relies upon Nykanen in view of Darago and applies to all the remaining independent claims on appeal, claims 1, 20, 30, 40, 41, and 42. As initially set forth by the Examiner in the statement of rejection of independent claim 1 at page 6 of the Answer, the Examiner takes the view that Nykanen does not explicitly teach that the message can be used to access the content by a second device associated with destination address. In turn, the Examiner then relies upon the teachings of Darago for this limitation and argues the combinability of them within 35 U.S.C. § 103. A similar approach is taken by the Examiner with respect to the remaining independent claims in succeeding pages of the Answer.

We note that pages 21 and 22 of the principal Brief on appeal considers the two rejection under 35 U.S.C. § 103 of claims 1-18 and 20-42 as a group. The features of independent claim 1 are considered representative. At the top of page 21 of the principal Brief on appeal, Appellants take the view that Darago is not analogous art. Since this

reference is utilized to reject all of the independent claims on appeal, except for independent claim 19, this amounts to a significant argument.

On the other hand, the Examiner's responsive arguments beginning at the bottom of page 17 as to the rejections under 35 U.S.C. § 103 do not address this argument of nonanalogous art of Darago. Additionally, to the extent the paragraph bridging pages 17 and 18 of the Answer is of the view that the Appellants are arguing the lack of motivation to modify Nykanen with Osaku, there is no rejection before us relying upon these two rejections alone. Additionally, the Examiner's comments with respect to references labeled Barr and Beelitz at the bottom half of page 18 are apparently misplaced since these references are not relied upon by the Examiner in this appeal. As correctly noted by Appellants, Darago does not appear to relate to wireless access protocols of the type set forth by Nykanen as well as reflected in the subject matter of the argued claims on appeal. The Examiner's reliance upon the paragraph bridging columns 6 and 7 of Darago as a basis of motivation for its combinability with Nykanen appears to be based upon only generalizations.

For all these reasons, we must reverse the rejection relying upon Nykanen and Darago and, in turn, the rejection relying upon Nykanen, Darago, and Osaku, because the Examiner has failed to provide adequate basis for the combinability of the respective references within 35 U.S.C. § 103 and because the Examiner has not addressed the argument that Darago is not analogous art.

Conclusions and Decision

In view of the forgoing, we have reversed the rejection of claim 19 under 35 U.S.C. § 102. Likewise, we have also reversed the two separately stated rejections under 35 U.S.C. § 103 encompassing claims 1-18, and 20-42. Therefore, all rejections of all claims on appeal are reversed.

REVERSED

PEB

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